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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,613	03/20/2001	Heinz Isak	49458	4678

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WASHINGTON, DC 20036

EXAMINER

TUCKER, ZACHARY C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/22/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,613

Applicant(s)

ISAK ET AL.

Examiner

Zachary C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of
Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The previously stated rejection of claims 1-4 is hereby withdrawn in view of applicant's arguments and the amendment to claim 1, introducing language that clarifies the possible identities of the variables in the structural formula depicted in claim 1.

The word "drying" is the present participle form of the verb "to dry." Since it has a meaning that is generally understood, it is no longer considered to be indefinite.

Status of
Claim Rejections - 35 USC § 103
and

Response to Arguments

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 4 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,221,762 (Wingert et al) for reasons of record in paper number 5, and further for reasons given hereinbelow:

Applicant, in rebuttal to the rejection of claims 1,2 and 4 as being unpatentable over the Wingert et al patent, states that one of skill in the art would not interpret the

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word the way the examiner has interpreted it; *i.e.* that "drying" signifies that water and/or solvent is actively being removed from that which is being dried.

The definition of "drying" as it appears in the Hawley's Condensed Chemical Dictionary, 13th ed. has been supplied by applicant to show that the word means *removal of 90-95% of the water from a material...*, and therefore, the Wingert et al reference does not apply to the instantly claimed process.

Certainly, applicant does not wish to be bound to a process for removing only water from a phenoxymethylbenzoic acid of the general formula I. Claim 1 clearly specifies that the compound of general formula I is either water- and/or solvent- wet. To meet the claim limitations, the phenoxymethylbenzoic acid of general formula I does not have to contain any water at all.

Therefore, the definition of drying supplied with applicant's response is not commensurate in scope with the process that is instantly claimed, and at least for this reason is not probative.

The definition of "drying" from Van Nostrand's Scientific Encyclopedia, 7th ed., pages 939-943 is supplied herewith. The Van Nostrand's definition states the word means removal of a liquid (an organic solvent or water) from a solid, solution, slurry, sludge or paste.

Page 941 of Van Nostrand's describes "dehydration," and the definition given therefor is almost exactly the same as the one supplied by applicant for "drying."

Applicant's response is also not persuasive for a purely grammatical reason:

The word "drying" is the present participle form of the verb "to dry." The present participle form of a verb indicates that an action is in the process of occurring; that it is not necessarily completed.

In other words, that the process of drying is occurring does not mean that whatever is being subjected to the drying process is rendered completely or 95% or to any other degree free of the water or solvent contained therein. Drying might be stopped before completed, and the action of "drying" nevertheless would have still been taking place.

For this reason, any degree of solvent or water removal meets the definition of the word "drying" because what is claimed is a process of drying a compound of general formula I at 1-25°C above its melting point, there is no specified limitation requiring the compound of general formula I to be rendered 95% free of solvent or water.

Wingert et al discloses heating a solvent-containing melt of phenoxymethylbenzoic acid.

In applicant's characterization of the Wingert et al process (steps a-d), it is not clear where he found the passage stating there is no phenoxymethylbenzoic acid in step c or the passage stating that a melt of phenoxymethylbenzoate is formed in step c.

Col. 12, lines 30-35 of Wingert et al teach that only a 1-6% excess of base are added to convert the phenol reactant to the corresponding phenolate. Indeed, in examples 1 and 2, the sodium methylate is reacted in 4% excess of either o-cresol (2-methylphenol) or phenol. In such a reaction, almost all of the sodium methylate is neutralized by the phenolic OH- groups, and only 0.06 mole of residual base are

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present in the mixture when the phenolate is reacted with 2.0 moles of lactone in the next step. Such a relatively small amount residual base would hardly cause more than only a negligible amount of phenoxyethylbenzoate to be present in the reaction mixture after the phenolate and lactone are reacted.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Because the rejection of claims 1-4 under 35 U.S.C. 112, second paragraph has been withdrawn, claim 3 is now only objected to.

An amendment to claim 1, specifying an additional step of obtaining the compound of general formula I substantially or 95% free of any water or solvent, would be looked upon favorably.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

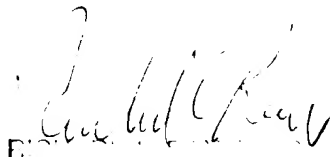
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (703) 305-2050. The examiner can normally be reached Monday-Friday from 7:00am to 3:30pm. If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mukund Shah, can be reached at (703) 308-4716. The fax number for the organization where this application or proceeding is assigned is (703) 308-4556 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Zachary Tucker
Examiner